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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,792	12/31/2001	Daniel Steven Kline	85447.000052	2970

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PATENT LEGAL STAFF  
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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/038,792

Applicant(s)

KLINE ET AL.

Examiner

Mark A Osele

Art Unit

1734

eh

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,9-12,26 and 28-31 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-25 is/are rejected.
- 7) ☒ Claim(s) 8 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Haas et al. Haas et al. shows a transfer application and peel apparatus for peeling a donor, 82, from a laminated printed media comprising: a support path (column 11, lines 19-39) for conveying a plurality of attached laminated printed articles along a first path; and a peel guide (L-shaped member below element number 88A in Fig. 10), for guiding the donor to a donor take-up reel, 84, the peel guide positioned so that the angle between the donor and the laminated article remains substantially constant as the donor take-up reel fills with donor and changes the angle at which the donor leaves the peel guide (See Fig. 10). It is noted that the layer transferred to the substrates is a printed layer not an overcoat layer, but the limitations of the materials worked upon are not given patentable weight in an apparatus claim.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hagstrom. Hagstrom shows a transfer application and peel apparatus for peeling a donor, 17, from

Art Unit: 1734

a laminated printed media comprising: a support path, 22, for conveying a plurality of attached laminated printed articles along a first path; and a peel guide, 24 (leftmost of two element 24 rollers), for guiding the donor to a donor take-up reel, 20, the peel guide positioned so that the angle between the donor and the laminated article remains substantially constant as the donor take-up reel fills with donor and changes the angle at which the donor leaves the peel guide (See Fig. 1).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Mochizuki. As shown in paragraph 3 above, Hagstrom shows the instantly claimed features except for a pair of rollers as the peel guide. Mochizuki teaches that a pair of drive rollers, 32c, can carry a donor web to a take-up reel (column 4, lines 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second roller to the peel guide of Hagstrom in order to create a carrying nip for moving the web so that the pulling force is not handled by the take-up reel alone.

Art Unit: 1734

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Mochizuki as applied to claim 5 above, and further in view of Ohta. Ohta et al. shows a lamination device wherein the exit platen, 34, is angled with respect to the paper path. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an angled platen in the apparatus of the references as combined because Ohta et al. shows that this type of platen allows for gravity to bring the peeled, laminated articles out of the apparatus.

7. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Ohta. As shown in paragraph 3 above, Hagstrom shows the instantly claimed features except the angled exit platen. Ohta et al. shows a lamination device wherein the exit platen, 34, is angled with respect to the paper path. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an angled platen in the apparatus of Hagstrom because Ohta et al. shows that this type of platen allows for gravity to bring the peeled, laminated articles out of the apparatus.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Ohta as applied to claim 15 above, and further in view of Haas et al. Haas et al. shows paper supports, 150, 154A, proximate the peel guide to guide the printed media downstream of the peeling station (See Fig. 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add

paper supports to the apparatus of the references as combined for further conveyance of the printed media to downstream processing stations.

9. Claims 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Paulson et al. As shown in paragraph 3 above, Hagstrom shows the claimed limitations except for a donor guide and an exit roller. Paulson et al. shows a peeling apparatus further comprising a donor guide (J-shaped member upstream of rollers 22 and 24) and an exit roller (unmarked) downstream of the peeling station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the donor guide of Paulson et al. into the apparatus of Hagstrom in order to reduce the sharp angle of the donor as it is laminated onto the substrate, thereby reducing tension in the donor web. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the exit roller of Paulson et al. to provide a conveyor for further downstream processing of the printed media.

10. Claims 21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Paulson et al. as applied to claim 20 above, and further in view of Mochizuki. Mochizuki teaches that a pair of drive rollers, 32c, can carry a donor web to a take-up reel (column 4, lines 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second roller to the peel guide of the apparatus of the references as combined above in order to create a

Art Unit: 1734

carrying nip for moving the web so that the pulling force is not handled by the take-up reel alone.

11. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagstrom in view of Paulson et al. and Mochizuki as applied to claim 24 above, and further in view of Ohta. Ohta et al. shows a lamination device wherein the exit platen, 34, is angled with respect to the paper path. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an angled platen in the apparatus of the references as combined above because Ohta et al. shows that this type of platen allows for gravity to bring the peeled, laminated articles out of the apparatus.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 3, 17-19, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 3 and 22 applicant further limits the apparatus to having a donor guide downstream of the peel guide to resist tension from the donor take-up reel. The addition of a donor guide downstream of the peel guide the path of the donor between the peel guide and donor guide would remain constant while

Art Unit: 1734

the angle at which the donor leaves the donor guide would change as the donor take-up reel fills with donor. As a consequence, the angle at which the donor leaves the peel guide would remain constant as the donor take-up reel fills with donor. This is contradictory to the limitations of claim 1. It is unclear how the limitations of both claims 1 and 3 can be met in the same apparatus.

Claim 17 recites the limitation "the peel guide" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

14. Claims 7, 9-12, 26, and 28-31 are allowed.

15. Claims 8 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 17-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action by adding the limitations to the peel guide as in claim 14.



### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1-6 and 13-25 have been considered but are moot in view of the new ground(s) of rejection. The argument as to combining Ohta with any of combination of references warrants a response as it is being used in this office action as well. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the angled exit platen causes the trailing edge of the media to release the interstitial laminate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's exit platen may have additional functions not shown by the angled receiving table of Ohta et al. but without structural limitations recited in the claims showing a distinction between the two elements there is no patentable weight given to this argument.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', is positioned above the printed name.

**MARK A. OSELE**  
**PRIMARY EXAMINER**

April 5, 2004